

**REMARKS**

**Amendments to Claims**

Claims 1 – 3 and 16 – 37 are amended to improve clarity.

**§ 101 Issue**

The Examiner asserts that claims 1-37 are allegedly drawn to non-statutory subject matter under 35 U.S.C. § 101. In particular, the Examiner asserts that the recited “information” that comprise the recited “databases” and “datasets” are non-functional descriptive matter. *See Office Action*, at pg. 3. Based on the alleged § 101 concerns, the Examiner appears to give no patentable to the features. *See Office Action*, at pp. 3-6.

Ordinarily, the Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Lowry*, 32 F.3d 1579, 32 USPQ.2d 1031, 1034 (Fed. Cir. 1994) (*citing In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 405 (Fed. Cir. 1983)); *see also In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”). Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89, 290 USPQ 1, 9 (1981). However, as a path of least resistance to advance prosecution, Applicant hereby amends claims 1-3 and 16-37 to clarify that the recited “databases” and “datasets”, and the “information” organized therein, are stored on computer readable tangible recording mediums. The Court of Appeals for the Federal Circuit has stated that the PTO must consider data structure claim limitations when determination patentability of an invention over the prior art. *See In re Lowry*, 32 F.3d 1579, 32 USPQ.2d 1031, 1034 (Fed. Cir. 1994) (reversing the finding of the PTO appeals board, finding that the Board erred by denying patentable weight to Lowry's data structure limitations).

Accordingly, Applicant submits that claims 1-37 are in compliance with 35 U.S.C. § 101, and are not drawn to non-functional descriptive matter, and respectfully requests that the Examiner consider all the limitations of the claims in determining their patentability over the prior art.

**Claim Rejections Over the Prior Art**

Effectively the remarks Applicant submitted with the Supplemental Amendment filed November 30, 2007 were not considered, because the Applicant relied heavily on features the Examiner refused to give patentable weight in order to distinguish the claims from the prior art. Since the above mentioned amendments address the Examiner's § 101 concerns, Applicant urges the Examiner to consider the remarks set forth in the Supplemental Amendment. For the Examiner's convenience, Applicant includes a copy of those remarks.

**Remarks As Set-Forth in the Supplemental Amendment:**

Applicant respectfully submits the following remarks to clarify the differences between the independent claims and Himmelstein, especially in light of the claim amendments.

Himmelstein discloses a system for bartering "Himmelstein Options". A Himmelstein option is, essentially, an option tied to an underlying asset (a security, commodity, etc.) where title to that option does not settle till a future date. Because title does not settle, the IRS does not treat agreements to trade Himmelstein Options as taxable events. See Himmelstein, col. 5, lines 44-55. In other words, title to the security or financial interest which is the subject of the Himmelstein Option is transferred at a future settlement date, and that is the taxable event. See Himmelstein, col. 6, lines 31-33.

Claim 1 (as amended) recites, *inter alia*:

a database storing information related to sets of assets wherein the sets of assets comprise relinquished assets and acquired assets;

each of said sets of assets including at least one asset apiece;

a processing engine coupled to said database and being operable to select a first set of assets eligible for a like kind exchange based on said information;

said processing engine being further operable to select a second set of assets eligible for combination with said first set of assets to produce a like kind exchange combination wherein the first set of assets comprises relinquished assets and the second set of assets comprises acquired assets;

Applicant respectfully submits that in addition to the differences presented in the Response, Himmelstein does not teach or suggest “a database storing information related to sets of assets wherein the sets of assets comprise relinquished assets and acquired assets”, as recited in claim 1.

As illustrated in the exemplary embodiment of paragraph [0032] of the specification of the present invention, relinquished vehicles are vehicles sold, for example, at an auction, while acquired vehicles are new vehicles that may be replacements for the old vehicles. The matching engine 109 of FIG. 1, selects groups of relinquished and acquired vehicles based on records of those transactions, which would be eligible for treatment as a like-kind-exchange.

In Himmelstein, contrary to the present invention, there are no “relinquished” or “acquired” assets. Rather, in Himmelstein, a barter begins with a Himmelstein Option connected to some underlying asset, and trades for a second Himmelstein Options to acquire the asset underlying the second Himmelstein Option at some future date. In other words, in Himmelstein, the barter has not traded to acquire the new asset. Thus, Himmelstein does not teach or fairly suggest “a database storing information related to sets of assets wherein the sets of assets comprise relinquished assets and acquired assets”, or a processing engine that can select and match “a first set of assets” and “a second set of assets”. And if this is the case, Himmelstein does not teach or fairly

suggest that the information upon which the processing engine basis the selection of sets “comprises a first tracking record comprising data reflecting the relinquishment of the at least one asset of the set of relinquished assets, and a second tracking record comprising data reflecting the acquisition of the at least one asset of the set of acquired assets”, as recited in claim 1.

Applicant respectfully submits that independent claim 1, and independent claims 2, 3, 16, 31-33, 35 and 37 are patentable at least for the reasons set forth above. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claims 1, 2, 3, 16, 31-33, 35 and 37, and claims 4-15, 17-30, 34 and 36 *at least* by virtue of their respective dependencies.

## **CONCLUSION**

Applicants respectfully submit that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the Examiner’s convenience.

To the extent that it is determined fees are due in connection with the filing of this Response, the Commissioner is hereby authorized to charge the undersigned’s Deposit Account No. 50-0206. The Commissioner is also hereby authorized to credit any difference to the undersigned’s Deposit Account No. 50-0206.

Respectfully submitted By: /s/ Andrew J. Baca, Dated: July 21, 2008

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